



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 074273/0195

2681
#5
12-12-03

Applicant: Hiroyuki TOBA
Title: MOBILE COMMUNICATION TERMINAL WITH EXTERNAL
DISPLAY UNIT
Serial No.: 10/090,792
Filed: March 6, 2002
Examiner: Unknown
Art Unit: 2681

RECEIVED

DEC 10 2003

Technology Center 2600

**INFORMATION DISCLOSURE STATEMENT
UNDER 37 CFR §1.56 and 37 CFR §1.97**

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

RECEIVED
DEC 11 2003
TC 2600

Sir:

Submitted herewith on Form PTO-SB/08 is a listing of documents known to Applicant in order to comply with Applicant's duty of disclosure pursuant to 37 CFR 1.56. A copy of each listed document is being submitted to comply with the provisions of 37 CFR 1.97 and 1.98.

The submission of any document herewith, which is not a statutory bar, is not intended as an admission that such document constitutes prior art against the claims of the present application or that such document is considered material to patentability as defined in 37 CFR §1.56(b). Applicant does not waive any rights to take any action which would be appropriate to antedate or otherwise remove as a competent reference any document which is determined to be a prima facie prior art reference against the claims of the present application.

TIMING OF THE DISCLOSURE

The instant Information Disclosure Statement is believed to be filed in accordance with 37 C.F.R. 1.97(b), prior to the mailing date of a first Office Action on the merits (first scenario). If that is not the case, such as in a second scenario in which a first Office Action on the merits has been mailed before the filing of the instant Information Disclosure Statement, then either a certification or fee is required, and a certification is provided below. If neither of the first or second scenarios is the case, such as if a final Office Action or a notice of allowance has been mailed by the PTO (third scenario), then both a certification and fee are required, and in that case a certification is provided below and also the PTO is authorized to obtain the necessary fee to have the instant IDS considered, from Foley & Lardner Deposit Account #19-0741.

CERTIFICATION

The undersigned hereby certifies in accordance with 37 C.F.R. §1.97(e)(1) that each item of information contained in this Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three (3) months prior to the filing of this Statement.

RELEVANCE OF EACH DOCUMENT

A translation of a portion of a Chinese Office Action that issued September 12, 2003 with respect to a counterpart Chinese patent application is provided below.

"As stated in the description, this application relates to a mobile communication terminal with external display unit, After examination, the Examiners comments are hereby given as follows: Claim 1 does not possess inventiveness and not conform to the provision of Art 22, pro. three of the Patent Law. D1 has disclosed an apparatus and method for displaying information in folder type communication terminal, wherein (claims 1 and 3 and line 13, page 2 to line 2, page 8 of the description and Figs. 1 and 2) the following technical features have been disclosed: an apparatus for displaying information in a folder type communication terminal (the first line of claim 1), comprising a duplex 112 transfers signals

received by an antenna ANT to a radio frequency (RF) receiving unit and transfers the received data to a control unit 111 (see lines 29-32, page 3 of the description of D1), said apparatus has the same function as the receiving section for receiving call from a counter end stated in the present invention; a display unit mounted in an opening formed through a portion of the folder, the display unit being transparent at both surfaces thereof (see lines 4-5 of claim 1), a main display unit provided on an inner surface exposed when said mobile terminal is in an opened state (see identifier 30 in Fig. 2) and an external display unit provided on an outer surface exposed when said mobile terminal is in a closed state (see identifier 30 in Fig. 1); a control unit for designating a selected one of the display status address regions based on the sensing signal from the sensing unit, thereby conducting control operation for allowing the image to be displayed in a normal status on the display unit (see lines 11-12 of claim 1), that is to say, displaying on the main display unit when said mobile terminal is in an opened state while displaying on said external display unit when said mobile terminal is in a closed state (see lines 26-28 of claim 3); a driving unit for driving the display unit under the control of the control unit (see line 13 of claim 1). The difference between the technical contents disclosed in D1 and the technical solution claimed in claim 1 is that D1 adopted a liquid crystal screen to realize the functions of the main display unit and the external display unit, however, this is a piece of generally known knowledge. It is obvious for those skilled in the art to obtain the technical solution claimed in claim 1 on the basis of D1 in combination with the generally known knowledge. Therefore, claim 1 does not possess prominent substantive features, nor does it represent notable progress; accordingly, it does not possess inventiveness.

The additional technical features of dependent claim 2 has also been disclosed by D1 as: a sensing unit for detecting whether a folder of the communication terminal is opened or closed, and generating a sensing signal according to the sensed status of the folder (see lines 2-3 of claim 1); a control unit for designating a selected one of the display status address regions based on the sensing signal from the sensing unit, thereby conducting control operation for allowing the image to be displayed in a normal status on the display unit (see lines 11-12 of claim 1). Therefore, claim 2 does not conform to the provision of Art. 22, para. three of the Patent Law, either.

The additional technical features of dependent claims 3-5 belong to the generally known knowledge in the art and are obvious for those skilled in the art; thus said claims do not possess prominent substantive features, nor do they represent notable progress; accordingly, they do not possess inventiveness.

The additional technical features of dependent claim 6 has also been disclosed by D2 (see Fig 2 and lines 24-27, col. 2 of D2) as: when the handset is in the cradle, the back keypads control the back display (see lines 24-27, col. 2 of the description). It is obvious for those skilled in the art to obtain the technical solution claimed in claim 6 on the basis of D1 in combination with D2 and such combination fails to produce any unexpected technical effect. Therefore, claim 6 does not possess prominent substantive features, nor does it represent notable progress; accordingly, it does not possess inventiveness as prescribed in the provision of Art. 22, para. three of the Patent Law.

The additional technical features of dependent claims 7-8 belong to the generally known knowledge in the art and are obvious for those skilled in the art; thus said claims do not possess prominent substantive features, nor do they represent notable progress; accordingly, they do not possess inventiveness.

The additional technical features of dependent claim 9 has also been disclosed by D2 (see Fig. 2 and lines 24-27, col. 2 of D2) as: when the handset is in the cradle, the back keypads control the back display (see lines 24-27, col. 2 of the description). It is obvious for those skilled in the art to obtain the technical solution claimed in claim 9 on the basis of D1 in combination with D2, and such combination fails to produce any unexpected technical effect. Therefore, claim 9 does not possess prominent substantive features, nor does it represent notable progress; accordingly) it does not possess inventiveness as prescribed in the provision of Art. 22, para. three of the Patent Law.

The additional technical features of dependent claims 10-13 belong to the generally known knowledge in the art and are obvious for those skilled in the art; thus said claims do not possess prominent substantive features) nor do they represent notable progress; accordingly, they do not possess inventiveness.

The additional technical features of dependent claim 14 has also been disclosed by D1 as: a sensing unit for detecting whether a folder of the communication terminal is open or closed, and generating a sensing signal according to the sensed status of the folder (see lines 2-3 of claim a control unit for designating a selected one of the display status address regions based on the sensing signal from the sensing unit, thereby conducting control operation for allowing the image to be displayed in a normal status on the display unit (see lines 11-12 of claim I). Therefore, claim 14 does not conform to the provision of Art. 22, para. three of the Patent Law.

The additional technical features of dependent claims 15-47 belong to the generally known knowledge in the art and are obvious for those skilled in the art; thus said claims do not possess prominent substantive features, nor do they represent notable progress; accordingly, they do not possess Inventiveness.

For the aforementioned reasons, neither the independent claims nor the dependent claims possess inventiveness, and meanwhile, no essential contents which can be granted the patent right are stated in the description. Hence, even if the applicant reorganizes and/or makes further definitions to the claims according to what is stated in the description, it is very much unlikely for the present application to be granted the patent right. If the applicant cannot present convincing reasons to prove the inventiveness of the present application within the time limit fixed in the present Office Action, this application will be rejected."

Applicant's statements regarding the Chinese Office Action are based on a partial translation that Applicant's representative obtained. These statements should in no way be considered as an agreement by Applicant with, or an admission of, what is asserted in the Chinese Office Action.

Applicant respectfully request that the listed documents be considered by the Examiner and formally be made of record in the present application and that an initialed copy of Form PTO/SB/08 be returned in accordance with MPEP §609.

Respectfully submitted,

December 9, 2003
Date

Phillip J. Articola
Phillip J. Articola
Registration No. 38,819

FOLEY & LARDNER
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5143
Telephone: (202) 672-5300
Facsimile: (202) 672-5399